

### **Remarks**

#### **Specification Objections**

Applicants gratefully note withdrawal of the objection to the specification.

#### **35 USC 112**

Applicants note withdrawal of the rejection under 35 USC 112, second paragraph. Further, Applicants note Examiner's indication that the rejections under 112, first paragraph are overcome, and accordingly, withdrawn. Thus all rejections under 35 USC 112 are now withdrawn.

#### **35 USC 103**

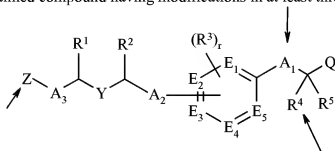
Applicants note that Applicants' arguments regarding the 35 USC 103 rejection over Tajima and Takagi have been fully considered, found persuasive, and the rejection is withdrawn. Further Applicants note that Applicants' arguments regarding 35 USC 103 rejection over Moishita in view of Brooks have been considered persuasive and are now withdrawn,

Applicants note that the remaining rejection under 35 USC 103 in light of Kojima is maintained. Applicants respectfully traverse the rejection and request further consideration in light of the following. Applicants note the Examiner's reference to the A1 position, wherein the broad genus claim of Kojima embraces values for m at the A1 position that may range from 0 to 6. However, Applicants maintain that the specification directs the artisan to prepare genus compounds having a longer linker at the A1 position. For example, there are numerous examples wherein m is 3, 4 or 5. Kojima includes no substituted pyridyl compounds, nor, in fact, any examples, with a linker that is less than 3 carbon atoms. Kojima in no way suggests that it is desired to prepare Applicants' single carbon linker compounds, and in no way suggests the additional phenyl group in the linker (B of Claim 1), or hydrogen substituted carbon adjacent to the A1 linker.

Additionally, the Examiner suggests that Kojima discloses compounds of Formula I may be substituted with phenyl; however, Applicants maintain that the disclosure at lines 31-33, column 4 refer to an entirely different scaffold having a thiazole in the linker. The variable "D" referred to in column 4 is bound to a thiazole (Formula Ia) and as illustrated by Example 2. Applicants could identify no teaching or suggestion that the phrase "pyridyl" (variable A as used in claim 1), was intended to embrace or envision both substituted and unsubstituted final pyridyl products of Formula I. That is, no compounds of formula I wherein the pyridyl (A) directly bound to the linker B of

Claim 1 is at all contemplated to be substituted. The disclosure in the specification point to compounds wherein the A group is a thiazole optionally having substituents that may include pyridyl as a substituent on the thiazole (the cited column 4). Additionally, the teachings of the specification overwhelmingly direct the artisan to prepare thiazole or imidazole compounds (at least Examples 1-41 out of 46 examples).

Applicants maintain that the Kojima patent lacks guidance to select the one example compound 43 or 42 from the overwhelming teachings toward compounds having a thiazole or imidazole, to further select the necessary variables at 3 positions to prepare the compounds now claimed. For clarity, Applicants wish to point out that the present invention requires both selection and modification of Kojima on at least 3 positions to prepare the compounds now claimed. Additionally, it is important to keep in mind that the variable Z of Applicant's claim is limited to phenyl-T-pyridyl and naphthyl-T-pyridyl, wherein Kojima generally teaches thiazole and imidazole compounds having longer carbon linkers at position A1, substitution at the adjacent carbon atom linking Q. Applicants submit that the disclosure at column 4 in no way directs the artisan to prepare the presently claimed compound having modifications in at least three positions.



It remains necessary to show “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” but such reasoning “need not seek out precise teachings directed to the specific subject matter of the challenged claim.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Applicants submit that the teachings in the cited application in no way guide the artisan to prepare the compounds claimed herein. Applicants respectfully draw the Examiner's attention to the recent decision by the U.S. Court of Appeals for the Federal Circuit in *Takeda Chemical v. Alphapharm*, 492 F.3d 1350, 83 U.S.P.Q.2D 1169 (C.A.F.C. 2007). The court began by noting that:

[i]n addition to structural similarity between compounds, a prima facie case of obviousness also requires a showing of “adequate support in the prior art” for the change in structure. ( *Takeda*, 492 F.3d 1350 at 1356,

*quoting In re Grabiak*, 769 F.2d 729, 731-32 (Fed. Cir. 1985).

Applicants further note that the C.A.F.C. opinion in Takeda was issued after the decision by the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). The Takeda C.A.F.C. specifically noted:

The test for prima facie obviousness for chemical compounds is consistent with the legal principles enunciated in *KSR*. [...] Thus, in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound. (492 F.3d 1350 at 1356 and 1357.)

Applicants submit that nothing in any of the cited patents directs one of ordinary skill to select the one compound 43 from Kojima, to add a phenyl, remove the dimethyl substituents and select a value for m that is neither suggested nor exemplified to be a desired feature. It does not appear that the cited compounds were highlighted as being identified in any way as being superior to or even comparable to any other disclosed compound. Thus, Applicants submit that there is no reason for choosing the specific examples from the numerous examples and disclosures in Kojima in the quest for PPAR modulators. Indeed, there seems to be no other motivation that would guide one of ordinary skill to select these particular compounds for further modification. Applicants submit that the test for chemical obviousness delineated in *Takeda* and *KSR* has not been satisfied by the cited disclosures. Applicants respectfully submit that the chemical arts are unpredictable and that the cited references lack teachings to direct one of ordinary skill to choose the specific cited compounds or examples for further modification, from the broad disclosure focused on structurally diverse compounds, and the examples disclosed. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Remarks

Applicants respectfully request entry of the enclosed amendments and reconsideration in light of both the amendments and discussion submitted herewith. Applicants believe that the case is now in condition for allowance, and request favorable reconsideration.

Respectfully submitted,

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